

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KONSTANTINOS POULAKIS
And AXEL SCHULTE

Appeal 2006-1201
Application 09/743,710
Technology Center 1700

Decided: September 28, 2006

Before PAK, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Upon careful consideration of the record, we determine that this case is not in condition for a decision on appeal. Accordingly, we remand the subject application to the Examiner to take appropriate action not inconsistent with the instruction below.

At pages 3 and 4 of the Answer, the Examiner has objected to the specification under 35 U.S.C. § 132 as containing new matter and has

rejected claim 9 under 35 U.S.C. § 112, first paragraph, as lacking written description for the subject matter claimed. The Amendment filed on January 15, 2003, is said to introduce new matter into the specification and claim 9 on appeal. *Id.* at 3-4. As stated at page 4 of the previous Remand to the Examiner dated September 30, 2005,

The [E]xaminer indicates that the new matter in the specification is the phrase, “the subject matter of which is hereby incorporated by reference,” and the new matter added to claim 9 is the phrase, “a ferromagnetic coating extending throughout the entire length and width of the foam-inhibiting covering.” Answer 3-4.

The Examiner’s written description rejection of independent claim 9 has not been extended to dependent claims 10 through 18 even though they include the same limitation in question. See 37 C.F.R. § 1.75(c)(2004).

As a rebuttal to the objection and rejection in question, the Appellants rely on “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland” which is said to describe “SU-9182” and “the use of the Stahl SU-9182 product as the covering, including the ferromagnetic particles extending throughout its length and width...” See Br. 6-7, together with Amendment to paragraph [0017] of the Substitute Specification filed on January 15, 2003. According to page 4 of the previous Remand to the Examiner, the disclosure as originally filed designates “SU-9182” as “polyurethane SU-9182 of Firma Stahl” rather than as “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland.” See also Br. 6-7. Moreover, as indicated at pages 4-5 of the previous Remand to the Examiner, a certified English translation of “the polyurethane SU-9182 of

Stahl Holland B.V. of Waalwijk Holland” cannot be found in the image file wrapper of the application.

Therefore, upon return of this application to the Examiner’s jurisdiction, it is ordered that the Examiner:

- 1) Enter a new ground of rejection against claims 10 through 18 under 35 U.S.C. § 112, first paragraph, based on written description if the current written description rejection of claim 9 is to be maintained;
- 2) Obtain a certified English translation of “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland” and place them into the official file wrapper of the application; and
- 3) Determine whether the description of ”SU-9182” as “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland” violates the written description requirement of the first paragraph of 35 U.S.C. § 112. In this regard, we must emphasize that a mere attorney assertion that “polyurethane SU-9182 of Firma Stahl” is “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland” is not sufficient without any supporting objective evidence.

This application, by virtue of its “special” status, requires an immediate action. M.P.E.P. § 708.01(8th Ed., Rev. 2, May 2004). It is important that the Board be informed promptly of any action affecting the appeal in this case.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by

Appeal 2006-1201
Application 09/743,710

the Board. If the Examiner enters any new ground of rejection in the Supplemental Examiner's Answer, the Appellants may choose one of the two options provided in 37 C.F.R. § 41.39(b)(2004) within two months from the date of the Supplemental Examiner's Answer to "avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection."

REMANDED

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